

U.S. Pat. App. Ser. No. 10/018,149
Att. Docket No. 10191/2098
Reply To 12/02/03 Office Action

REMARKS

Claims 11 to 30 are now pending.

Applicant respectfully requests reconsideration of the present application in view of this response.

With respect to paragraphs one (1) and two (2) of the Office Action, Applicant thanks the Examiner for acknowledging receipt of the English translation of 9/9/03, and for acknowledging and approving the drawings of 9/9/03.

With respect to paragraph four (4), claim 11 (claim 1 was mistakenly indicated, as discussed with the Examiner on January 6, 2004) was objected to for a minor grammatical error, which has now been corrected as suggested by the Examiner. Approval and entry are respectfully requested.

With respect to the summary of the office action and as confirmed with the Examiner on January 6, 2004 in a telephone conference, it was indicated that claims 13 to 16, 18 and 21 to 30 contain allowable subject matter. While the rejections of the base claims may not be agreed with, to facilitate matters, claim 11 now includes the feature of allowable claim 13, the dependency of which has been changed from claim 11 to claim 15. Claim 12 now depends from allowable claim 16. Claims 15, 16, 18 and 21 have been rewritten as independent claims, as suggested. It is therefore respectfully requested that the objections be withdrawn, since claims 13 to 16, 18 and 21 to 30 are now allowable.

With respect to paragraph six (6), claims 11, 12, 17, 19 and 20 were rejected under 35 U.S.C. § 102(b) as anticipated by Eriksson et al., U.S. Patent No. 5,786,787.

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102, the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (See Scripps Clinic & Research Foundation v. Genentech, Inc., 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter, as discussed herein. (See Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

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As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art." (See M.P.E.P. § 2112; emphasis in original; and *see Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'l. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

While the rejections may not be agreed with, to facilitate matters, the claims have been rewritten as explained above. Claim 11 now includes the feature of claim 13. Claim 12 now depends from allowable claim 16. Claims 17, 19 and 20 now depend from allowable claim 11 as presented. It is therefore respectfully requested that the anticipation rejections be withdrawn as moot.

Accordingly, claims 11 to 30 are allowable.

CONCLUSION

In view of the foregoing, it is believed that the objections and rejections have been obviated, and that claims 11 to 30 are allowable. It is therefore respectfully requested that the objections and rejections be withdrawn, and that the present application issue as early as possible.

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Respectfully submitted,
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